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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,902	03/01/2004	Duane D. Fansler	59617US002	2589

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,902

Applicant(s)

FANSLER ET AL.

Examiner

Susan W. Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 2 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Election/Restrictions

Applicant's election of Group I, claims 1-18, in the reply filed on 08/19/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application contains claims 19-33 drawn to an invention nonelected with traverse in the response filed 08/19/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

Applicant argues that the hydrophilic poly(alkylene oxide) crosslinking agent recited in claim 1 distinguishes the instantly claimed composition from Lewandowski et al. This argument is not persuasive since Lewandowski et al teach that the "second oligomer" in the disclosed composition is a crosslinking oligomer and comprises a plurality of free radically polymerizable functional groups and can optionally comprise poly(alkylene oxide) groups [0029] and [0038] to [0043]. Applicant's argument is persuasive with respect to the crosslinking agent set forth in instant claim 2.

Applicant argues that that incorporation of photoinitiator into the disclosed oligomers is not taught by Lewandowski et al. This argument is unpersuasive. Lewandowski et al clearly teach that the first and/or second oligomer(s) may comprise polymerized monomer units having a pendant photoinitiator group. See [0043], [0089], [0099] and claim 9.

It is agreed that omitting the free radically polymerizable groups from the first oligomer disclosed by US '688 would defeat the purpose of crosslinking the first oligomer and the second oligomer taught by Lewandowski et al. It is noted that applicant teaches that the first component oligomer has pendent polymerizable groups thus, although these groups are not set forth in the claims, this is not the difference between the instantly claimed oligomers and the oligomers disclosed by US '688 (page 35 in the

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specification). The reasons for a finding of obviousness have been clarified herein in response to this argument.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-16 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Lewandowski et al [US 2005/007070688]. US '688 discloses compositions comprising a first component oligomer that can have pendent photoinitiator groups as well as pendent hydrophilic poly(alkylene oxide) groups and pendent free radically polymerizable groups. The differences from the instantly claimed first oligomer component are that pendent free radical polymerizable functional groups are not required in the instantly claimed oligomer and that pendent photoinitiator groups are optional in the US '688 oligomers. It is noted that applicant discloses such pendent polymerizable groups in the specification (page 35). The second oligomer component having pendent free radically polymerizable groups and optional poly(alkylene oxide) groups disclosed by Lewandowski et al corresponds to the second oligomer component as set forth in the instant claims. See paragraphs [0038] to [0047] of US '688.

It would have been obvious to one skilled in the art at the time of the invention to incorporate the optional photoinitiator groups in the "first oligomer" having pendent poly(alkylene oxide) groups taught by Lewandowski et al. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing a "built-in" photoinitiating function. Lewandowski et al provide motivation by teaching that the photoinitiator can be provided by one or both of the disclosed oligomers having a photoinitiating groups in paragraphs [0088] and [0089]. It would have been obvious to one skilled in the art at the time of the invention to include monomer units having poly(alkylene oxide)

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groups in the second oligomer disclosed by Lewandowski et al, as suggested by Lewandowski et al in paragraph [0043]. The free radically polymerizable pendent groups in the first oligomer taught by Lewandowski et al are encompassed by the comprising language in the claim description of the first component oligomer in the instant claims. It is noted that applicant discloses such pendent polymerizable groups in the specification (page 35).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/672580. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. Both applications claim a hydrophilic crosslinkable oligomer composition wherein one oligomer has pendent poly(alkylene oxide) groups and pendent photoinitiator groups and another oligomer is a poly(alkylene oxide) having polymerizable ethylenically unsaturated groups. See claims 1, 9, 18 and 20 of Appl. '580. See claims 1, 7, 8, 9 and 18 of the instant application. The comprising language of instant claim 1 description of a) encompasses the pendent free radically polymerizable functional groups set forth in claim 1 of A.N. '580, thus the first component oligomers can be the same, as set forth in instant claim 18. The second oligomer component can also be the same since the same oligomer is set forth in claim 20 of A.N. '580 and in instant claims 1, 7 and 8.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 2 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record and otherwise known to the examiner does not teach or suggest compositions as set forth in instant claim 1 wherein the crosslinking agent has the formula set forth in instant claim 2 or 17.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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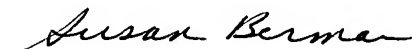
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB
10/27/05


Susan W Berman
Primary Examiner
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